

N THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Nelson Liang An Chang                          Art Unit : 2629  
Serial No. : 10/764,423                                  Examiner : Holton, Steven E.  
Filed : January 23, 2004                                  Confirmation No.: 2026  
Title : SYSTEMS AND METHODS OF INTERFACING WITH A MACHINE

Commissioner for Patents  
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RESPONSE TO ELECTION REQUIREMENT

In the Office action dated October 17, 2007, the Examiner has indicated that an election is required between the asserted "species" I and II. In response to this election requirement, applicant provisionally elects "species" I with traverse. Claims 1-32 read on the elected "species" I.

As explained in detail below, however, the election requirement is submitted to be improper because: (I) it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement; (II) the Examiner is not authorized under the Rules to issue the Election Requirement; (III) the Examiner has failed to establish a *prima facie* case for requiring an election of the claims; and (IV) no valid reason exists for dividing among the asserted "species".

I. IT WOULD NOT BE A SERIOUS BURDEN FOR THE EXAMINER TO CONTINUE EXAMINING THE APPLICATION ON THE MERITS

MPEP § 803.01 provides that (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the

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merits, even though it includes claims to independent or distinct inventions.

The Examiner already has searched and examined the entire application on the merits before issuing the above-mentioned Election Requirement. The Examiner's Election Requirement therefore is improper at the present stage of prosecution because it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement.

A summary of the prosecution history of the application is set forth below.

1/23/04        The application was filed with claims 1-64, where claims 1, 31, 32, 33, 63, and 64 were independent claims, claims 2-30 depended from claim 1 and claims 43-62 depended from claim 33.

3/22/07        The Examiner mailed the first Office action on the merits with the following claim rejections:

claims rejected 32 and 64 under 35 U.S.C. § 101;

claims rejected 1, 2, 4-12, 15, 19, 20, and 22-31 under 35 U.S.C. § 102(e) over Pryor (U.S. 7,042,440);

claims rejected 33, 34, 37, 39, 40, and 63 rejected under 35 U.S.C. § 102(e) over Pulli (U.S. 6,771,294);

claims 33 and 35 rejected under 35 U.S.C. § 102(a) over Kurtenbach (U.S. 2003/0142067);

claim 13 rejected under 35 U.S.C. § 103(a) over Pyror;

claim 3 rejected under 35 U.S.C. § 103(a) over Kumra (u.S. 6,204,852);

claims 16-18 and 21 rejected under 35 U.S.C. § 103(a) over Pyror in view of Schmalstieg (U.S. 6,842,175)

claims 36 and 38 rejected under 35 U.S.C. § 103(a) over Pulli;

claims 41-48, 52-60, and 62 rejected under 35 U.S.C. § 103(a) over Pulli in view of Pyror; and

claims 49-51 and 54 rejected under 35 U.S.C. § 103(a) over Pulli in view of Pryor and Scmmalstieg.

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6/21/07      Applicants mailed an Amendment in which:

independent claim 1 was amended to include the elements of claim 7, among other elements;

claim 7 was canceled;

claims 2-6, 9, 11, 13, 15-27, and 29 were left in their original form;

claims 8, 10, 12, 14, and 28 were amended;

claim 30 was rewritten in independent form;

independent claims 31 and 32 were amended to essentially track claim 1;

independent claim 33 was amended to incorporate the elements of claim 38;

claim 38 was canceled;

claims 34-37 and 39-63 were left in their original form;

independent claims 63 and 64 were amended to essentially track claim 33; and

dependent claim 65 was added.

10/17/07      The Examiner mailed the election requirement that is the subject of the instant Petition.

The Examiner already has fully and completely searched and examined the subject matter of all of the pending claims on the merits in the first Office action dated March 22, 2007. The scope of the subject matter recited in the pending claims is essentially the same as the subject matter scope of the claims that already have been fully and completely examined on the merits. Indeed, independent claims 33, 63, and 64 have been amended to incorporate only the elements of canceled claim 38, which the Examiner examined in the first Office action. Independent claims 1, 31, and 32 have been amended to incorporate the elements of canceled claim 7, which the Examiner examined in the first Office action. Although independent claims 1, 31, and 32 also have been amended to include elements that refer to "capture times" instead of "reference

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times" as originally recited, these amendments did not change the invention defined in these claims to a species that is different from the species originally defined by these claims.

Therefore, it would not be a serious burden for the Examiner to continue examining the application on the merits, regardless of whether the application includes claims that are independent and distinct.

For at least this reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

## II. THE EXAMINER IS NOT AUTHORIZED TO ISSUE THE ELECTION REQUIREMENT

The Examiner is not authorized to issue the election requirement date October 17, 2007, because: (A) the Rules do not permit the Examiner to issue an election requirement where there is no generic claim; and (B) the Rules do not permit the Examiner to issue an election requirement that is incomplete.

### (A) The Rules Do Not Permit The Examiner To Issue An Election Requirement Where There Is No Generic Claim

The election requirement is traversed because the Examiner is not authorized to require the proposed election of "species". In particular, 37 CFR 1.146, which authorizes the Examiner to require an election of species, applies only to "an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby." The instant application, however, currently does not contain a generic claim that embraces all the "species" I and II identified by the Examiner. Without such a generic claim, the "species" I and II do not constitute species to which the claims properly can be restricted under 37 CFR 1.146 (see MPEP § 806.04).

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

(B) The Rules Do Not Permit The Examiner To Issue An Incomplete Election Requirement

In the Office action dated October 17, 2007, the Examiner has required applicant to elect between the “species” I and “species” II. In accordance with the Examiner’s position, claims 1-32 correspond to “species” I, and claims 33-37 and 64 correspond to “species” II. The Examiner, however, has not provided any indication of how the pending claims 38-63 and 65 would be treated under the election requirement. Therefore, the Examiner has failed to provide a clear and detailed record of the election requirement as mandated under MPEP §§ 814 and 815.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

III. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE FOR REQUIRING THE PROPOSED ELECTION OF CLAIMS

In the Office action dated May 22, 2007, the Examiner has required an election between Species I (claims 1-32) and Species II (claims 33-37 and 64).

The specification discloses that the asserted “species” I and II are related. For example, the specification discloses an embodiment that includes the elements of the asserted “species” I (i.e., a spatiotemporal input data structure as defined in independent claims 1, 31, and 32) and the elements of the asserted “species” II (i.e., an arrangement of display space, viewing space, and interactive space as defined in independent claims 33, 63, and 64) (see, e.g.: page 24, lines 8-19; page 4, line 29 - page 5, line 9; page 5, lines 11-13 and page 6, lines 3-12; and FIGS. 1 and 14).

In the case of related inventions, MPEP § 806.05(j) explains that (emphasis added):

To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02. See MPEP § 806.05(c) for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a combination/subcombination relationship. For other related

product inventions, or related process inventions, the inventions are distinct if

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented.

The only explanation given by the Examiner in support of the election requirement is that:

The species are independent or distinct because Species II has no requirement of needing a spatiotemporal data structure as described in the Species I, and Species I has no specific requirements of the arrangement of display space, viewing space, and interactive space, as described in Species II.

Thus, the Examiner's election requirement is premised solely on his conclusion that the asserted "species" are mutually exclusive from each other. Under MPEP § 806.05(j), however, mutual exclusivity is insufficient by itself to establish that the species are either independent or distinct. Therefore, the Examiner has not made the showing required under MPEP § 806.05(j) and, consequently, has not established a *prima facie* basis for requiring election between each of the asserted "species" I and II.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

#### IV. No Valid Reason Exists for Dividing Among the Related Inventions

In general, if "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions" (MPEP § 808.02).

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The Examiner has not provided any basis for believing that the classification of the asserted "species" I and II is not the same, nor has the Examiner provided any basis for believing that the field of search of the asserted "species" I and II is not the same. To the contrary, the fact that the Examiner already has examined the subject matter corresponding to the asserted "species" I and II in the first Office action (see § I above) evidences the fact that the classification of the asserted "species" I and II is the same and the field of search of the asserted "species" I and II is the same. The Examiner also has not provided any clear indication that the classification of the asserted "species" I and II would be different in the future. Thus, the Examiner has not shown that separate examinations are required for the asserted "species" I and II. Accordingly, under MPEP § 808.02 "no reasons exist for dividing among related inventions" and the election requirement should be withdrawn.

For at least this additional reason, Applicant request that the Examiner reconsider and withdraw the election requirement.

## V. CONCLUSION

For at least the reasons explained above, Applicants request that the Director set aside the Examiner's Election Requirement dated October 17, 2007.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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